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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL T. PAPALIA and DOUG MORRIS

Appeal 2007-4163
Application 09/617,067
Technology Center 3600

Decided: January 30, 2008

Before WILLIAM F. PATE, III, DAVID B. WALKER, and JOSEPH A.
FISCHETTI, *Administrative Patent Judges*.

PATE, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's
final rejection of claims 1, 2, 4-8, 10-19, 21, and 22, all the claims currently

pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

Appellants' claimed invention is directed to control means used with distributed generation power systems (Spec. 1:23-24). Claims 1 and 10, reproduced below, are representative of the subject matter on appeal.

1. A system for operating power machines, comprising:
 - a. a plurality of power machines, the power machines each comprising control circuitry coupled thereto; and
 - b. a remote means for actuating the power machines comprising:
 - i. a means for monitoring a market price of electricity;
 - ii. a means for monitoring a market price of hydrocarbon fuels; and
 - iii. a mean for calculating the difference between the market price of electricity and the market price of hydrocarbon fuels; wherein after the remote means for actuating the power machines transmits an actuation signal to the power machines, the control circuitry evaluates local data stored therein prior to actuating the power machines.

10. A system for generating power machine actuation data, comprising:
 - a. a plurality of power machines, the power machines each comprising control circuitry coupled thereto, wherein the control circuitry comprises:
 - i. a means for monitoring local data; and
 - ii. a means of considering electricity generation factors;

- b. a remote means for actuating the power machines comprising:
 - i. a means of comparing the market price of electricity and hydrocarbon fuel;
 - ii. a means of transmitting an actuation signal; and
 - iii. a means of transmitting an override signal,wherein the control circuitry evaluates the local data after receipt of the actuation signal;
further wherein the control circuitry omits evaluation of the local data upon receipt of the override signal.

THE REJECTIONS

The Examiner relies upon the following evidence in the rejections:

Chasek	US 5,237,507	Aug. 17, 1993
Norris	US 5,510,780	Apr. 23, 1996
Edelman	US 6,281,601 B1	Aug. 28, 2001

The following rejections are before us for review.

1. Claims 1, 2, 4-8, 10-19, and 22 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Chasek and Edelman.
2. Claim 21 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Chasek, Edelman, and Norris.

ISSUES

Appellants contend “that the combination of Chasek and Edelman fails to teach all of Applicants’ claimed limitations” (Br. 5). More specifically, Appellants contend that the combinations fail to “teach control circuitry that evaluates local data after the receipt of a control signal and before actuation of the power machines” (*Id.*) (emphasis in original) and/or “*omitting* evaluation of the local data upon receipt of the override signal” (Br. 6) (emphasis in original). The Examiner did not give these limitations patentable weight because he found the limitations “to indicate an intended

use of the system” (Answer 4 and 6). The issue before us is whether these limitations should be given patentable weight.

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Chasek teaches a system that generates, disseminates, and displays information which permits a step-by-step introduction of an electronically simulated free market economic operation by regulated electric utilities and their associated power pool. The system includes sensors, computers, and displays that are linked by telephone lines and radio transmissions. The sensors monitor individual consumer energy usage as a function of hourly calendar-time, power output from each utility’s generators, and mean out-of-doors temperatures (Chasek, col. 1, l. 66 to col. 2, l. 9). However, Chasek fails to teach power machines comprising control circuitry configured to evaluate local data after receipt of an actuation signal and before actuating the power machine or to omit evaluation of the local data upon receipt of an override signal.

2. Edelman teaches a turbo-generator power control system and method that incorporates control strategies to vary power output based on a utility rate schedule (Edelman, col. 1, ll. 45-48). However, Edelman fails to teach the power control system is configured to evaluate local data after receipt of an actuation signal and before actuating the power machine or to omit evaluation of the local data upon receipt of an override signal.

3. Norris teaches a security code activation control system for controlling the operation of equipment which is leased or sold on an extended payment plan (Norris, col. 1, ll. 7-10). However, Norris fails to teach the control system is configured to evaluate local data after receipt of an actuation signal and to omit evaluation of the local data upon receipt of an override signal.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

Rejection of claims 1, 2, 4-8, 10-19, and 22 over Chasek and Edelman

Appellants argue claims 1, 2, and 4-8 as a group (Br. 5). We select claim 1 as a representative claim and the remaining claims of the group stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

In rejecting claim 1, the Examiner did not give the limitation “wherein [the] control circuitry evaluates [the] local data after the receipt of a control signal and before actuation of the power machines” patentable weight because the Examiner considered it “to indicate an intended use of the system” (Answer 4). More specifically, the Examiner considers the limitation “as being non-functional” (Answer 11). We disagree.

Independent claim 1 defines a system for operating power machines. The claimed system includes, *inter alia*, a plurality of power machines comprising control circuitry coupled thereto and a remote means for actuating the power machines. In addition, claim 1 further recites “after the remote means for actuating the power machines transmits an actuation signal to the power machines, the control circuitry evaluates local data stored therein prior to actuating the power machines.” The later limitation is not an intended use of the system but rather a recitation of specific functionality contained within the control circuitry of the power machines. Accordingly, this limitation should be given patentable weight, at least to the extent that the proposed combination is capable of performing the subject function. *See In re Schreiber*, 128 F.3d 1473, 1479 (Fed. Cir. 1997).

The combination of Chasek and Edelman fails to teach or suggest control circuitry that evaluates local data after the receipt of a control signal

and before actuation of the power machine (Finding of Facts 1-2). As such, we cannot sustain the Examiner's rejection of claims 1, 2, and 4-8.

Appellants argue claims 10-19 and 22 as a group (Br. 5). We select claim 10 as a representative claim and the remaining claims of the group stand or fall with claim 10. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

In rejecting claim 10, the Examiner did not give the limitation "wherein the control circuitry omits evaluation of the local data upon receipt of the override signal" patentable weight because the Examiner found the limitation "to indicate an intended use of the system" (Answer 6). Again, we disagree.

Independent claim 10 defines a system for generating power machine actuation data. The system includes, *inter alia*, a plurality of power machines comprising control circuitry and remote means for actuating the power machines. In addition, the control circuitry is configured to evaluate "local data after receipt of an actuation signal" and to omit "evaluation of the local data upon receipt of an override signal." The omission of the evaluation of the local data is not an intended use of the system but rather a recitation of functionality contained within the control circuitry of the power machines. As such, the limitation should be given patentable weight, at least to the extent that the proposed combination is capable of performing the subject function. *See In re Schreiber*, 128 F.3d 1473, 1479 (Fed. Cir. 1997).

The combination of Chasek and Edelman fails to teach or suggest control circuitry that omits evaluation of the local data upon receipt of an override signal (Finding of Facts 1-2). As such, we cannot sustain the Examiner's rejection of claims 10-19 and 22.

Rejection of claim 21 over Chasek, Edelman, and Norris

Claim 21 depends from claim 10. As discussed, *supra*, the combination of Chasek and Edelman fails to teach or suggest control circuitry that omits evaluation of the local data upon receipt of an override signal. Furthermore, Norris fails to overcome this deficiency (Finding of Fact 3). As such, we cannot sustain the Examiner's rejection of claim 21.

CONCLUSIONS OF LAW

We conclude that Appellants have shown that the Examiner erred in rejecting claims 1, 2, 4-8, 10-19, and 22 as unpatentable over Chasek and Edelman, and claim 21 as unpatentable over Chasek, Edelman, and Norris.

DECISION

The Examiner's decision to reject claims 1, 2, 4-8, 10-19, and 22 as unpatentable over Chasek and Edelman, and claim 21 as unpatentable over Chasek, Edelman, and Norris is reversed.

REVERSED

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